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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,226	03/23/2004	Henry Welling Lane	DIOP-07900	4994
34209	7590	01/21/2005	EXAMINER	
LAW OFFICE OF DEREK J. WESTBERG 2 NORTH SECOND STREET, SUITE 1390 SAN JOSE, CA 95113			MAI, HUY KIM	
			ART UNIT	PAPER NUMBER
			2873	

DATE MAILED: 01/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/808,226

Applicant(s)

LANE ET AL.

Examiner

Huy K. Mai

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 13-19, 35-42 and 46-53 is/are rejected.
- 7) ☒ Claim(s) 5-12, 20-34 and 43-45 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6/24/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The Information Disclosure Statement filed on June 24, 2004 is acknowledged.

Oath/Declaration

2. The declaration filed on March 23, 2004 is acceptable.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 53 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "the rib" (claim 53, line 3) has no antecedent basis.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 51-53 are rejected under 35 U.S.C. 102(b) as being anticipated by Conway (WO 99/56942).

The limitations in claims 51-53 are shown in Conway's Figs. 1-9, pages 3-7. Conway discloses an eyeglass assembly comprising: a eyeglass frame 12 having lens receptacles; and a pliable coating 12b,13b coupled to the eyeglass frame 12 and including a brow portion, the brow portion

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having side portions extending above the lens receptacles and the pliable coating having extensions coupled to the brow portion and extending downwardly along both sides of a wearer's nose.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-4,13-19,35-42,46-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Min (6,793,336) in view of Conway.

Regarding claims 1,13-15,35-37, Min discloses an eyeglass assembly comprising: a eyeglass frame 16 having lens receptacles; and a rib 36 coupled to the eyeglass frame and including a brow portion, the brow portion having side portions extending above the lens receptacles and the rib 36 having extensions coupled to the brow portion and extending downwardly along both sides of a wearer's nose and the rib having a pliable pad 12 on at least some of its surface. However, Min does not suggest the pliable pad is coated on the rib as claimed by the applicant. Conway discloses a technique to coat a pliable pad on an eyeglass frame for providing a soft comfortable fit while also providing a cushioning component between the user's face and the eyeglass frame. It would have been obvious at the time the invention was made to a person having skill in this art to modify the Min's device in light of Conway's teachings by providing a pliable coating on the frame for the same purpose as disclosed by Min and Conway as the same as the applicant does.

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Regarding claims 2-4,17-19, Min discloses the fastener 14,14'.

Regarding method claims 38,39,46-50, the device including means for performing the functions, as claimed in the method claims, is unpatentable over Min in view of Conway, as discussed above. It would have been obvious at the time the method is made to a person having skill in this art to recognize the steps in the Min in view of Conway's device for manufacturing the eyeglasses as the applicant claimed in claims 38,39,46-50.

Regarding claims 40-42, Min discloses the fastener 14,14'.

Allowable Subject Matter

9. Claims 5,8,20,23,30,43 and 45 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Claims 6,7,9-12,21,22,24-29,31-34 and 44 are objected as being dependent upon the above objected claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Mai whose telephone number is (571) 272-2334. The examiner can normally be reached on M-F (8:00 a.m.-4:30 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached on (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1562.



Huy Mai
Primary Examiner
Art Unit 2873

HKM/
January 18, 2005